



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2016-0001]

Request for Comments on the Application of the Written Description Requirement to Specific Situations in Design Applications

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice and Request for Comments.

SUMMARY: The United States Patent and Trademark Office (“USPTO” or “Office”) is evaluating how the written description requirement applies to certain design applications. In particular, the USPTO has developed a proposed approach for design examiners to apply general principles governing compliance with the written description requirement to specific situations in design applications. The USPTO is seeking public comment on the proposed approach as well as examples that the public believes would be helpful to illustrate the proposed approach or any suggested approach for applying the written description requirement in design applications.

DATES: Written comments must be received on or before [Insert date 60 days after publication in the FEDERAL REGISTER].

ADDRESSES: Comments should be sent by electronic mail message over the Internet (email) addressed to: DesignWrittenDescription2016@uspto.gov. Comments may also be submitted by mail addressed to: Mail Stop Comments – Patents,

Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Nicole D. Haines.

Although comments may be submitted by postal mail, the USPTO prefers to receive comments by email in order to facilitate posting on the USPTO's Internet Web site. Plain text is preferred, but comments may also be submitted in ADOBE® portable document format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper, and will be digitally scanned into ADOBE® portable document format.

The comments will be available for public inspection, upon request, at the Office of the Commissioner for Patents, currently located at Madison Building East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the USPTO's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION: Requests for additional information may be directed to Nicole D. Haines, Senior Legal Advisor, Office of the Deputy Commissioner for Patent Examination Policy, by telephone to (571) 272-7717, or to Erin M. Harriman, Legal Advisor, Office of the Deputy Commissioner for Patent Examination Policy, by telephone to (571) 272-7747. Alternatively, mail may be addressed to: United States Patent and Trademark Office, Mail Stop Comments – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Nicole D. Haines.

SUPPLEMENTARY INFORMATION:

I. Background

The USPTO held a roundtable on March 5, 2014 (“Roundtable”), to solicit public opinion regarding the written description requirement of 35 U.S.C. § 112(a), or pre-America Invents Act (“AIA”) 35 U.S.C. § 112, para. 1 (“35 U.S.C. § 112(a)”) as applied to design applications in certain limited situations. Specifically, the USPTO sought comments on the application of the written description requirement to an amended claim or a claim in a continuing design application (“later-claimed design”) that includes only a subset of originally disclosed elements (the later-claimed design does not introduce any new elements that were not originally disclosed). See Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications, 79 FR 7171 (Feb. 6, 2014) (“the Notice”). As discussed in the Notice, it has been the experience of the USPTO that in the vast majority of cases there is no question that a later-claimed design, composed of only a subset of originally disclosed elements, satisfies the written description requirement. In certain limited situations, however, the subset of originally disclosed elements, although visible in the original disclosure, composes a later-claimed design that an ordinary designer might not have recognized in the original disclosure. In those certain limited situations, a question arises as to whether the later-claimed design satisfies the written description requirement.

In the Notice, the USPTO requested input on its proposed factors-based approach, in which design examiners would consider certain enumerated factors when evaluating a claim for compliance with the written description requirement. The Roundtable featured public presentations and discussion of the topics identified in the Notice. The USPTO

also received written comments on the topics identified in the Notice and discussed at the Roundtable. Details of the Roundtable, as well as the public presentations, the USPTO's examples presented for discussion, the webcast recording, and the written comments received are available at <http://www.uspto.gov/patent/contact-patents/roundtable-written-description-requirement-design-applications>.

The USPTO considered all of the comments, both those expressed at the Roundtable and those received in writing. Responsive to these comments, the USPTO has decided not to pursue the factors-based approach set forth in the Notice. Also, in view of the comments, it became clear that there exists a need to supplement the current provisions in the Manual of Patent Examining Procedure ("MPEP") relating to 35 U.S.C. § 112 for design applications. A majority of the comments urged that the USPTO focus on precedent from the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") pertaining to written description issues in the context of design patents and applications. Specific emphasis was placed on Racing Strollers Inc. v. TRI Industries Inc., 878 F.2d 1418 (Fed. Cir. 1989) (en banc) and In re Daniels, 144 F.3d 1452 (Fed. Cir. 1998). Most comments suggested that these cases establish "a simple visual test" for determining compliance with the written description requirement; that is, the written description requirement is satisfied because the elements of the later-claimed design are visible in the original disclosure. Several comments also addressed In re Owens, 710 F.3d 1362 (Fed. Cir. 2013). In developing the proposed approach set forth in section III of this notice, the USPTO considered these Federal Circuit design cases, along with other seminal Federal Circuit cases concerning the written description requirement.

II. General Principles Governing Compliance with the Written Description

Requirement for Design Applications

35 U.S.C. § 112(a) provides that “[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same....” The Federal Circuit has explained that “requiring a written description of the invention plays a vital role in curtailing claims . . . that have not been invented, and thus cannot be described.” Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc). Further, “the purpose of the written description requirement is to ‘ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.’” Id., 598 F.3d at 1353-54 (citations omitted).

In evaluating written description, “the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” Id., 598 F.3d at 1351 (citations omitted). See also Daniels, 144 F.3d at 1456. With respect to showing possession, the Federal Circuit has emphasized that “the hallmark of written description is disclosure” and “[t]hus, ‘possession as shown in the disclosure’ is a more complete formulation.” Ariad, 598 F.3d at 1351. Accordingly, “the test requires an objective inquiry into the four corners of the specification from the perspective of a person of

ordinary skill in the art” and “[b]ased on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” Id.

The test for sufficiency of written description is the same for design and utility patents. Daniels, 144 F.3d at 1456. For designs, “[i]t is the drawings of the design patent that provide the description of the invention.” Id. (stating, “Although linguists distinguish between a drawing and a writing, the drawings of the design patent are viewed in terms of the ‘written description’ requirement of Section 112.”).

In Racing Strollers, the Federal Circuit stated, “[a]s a practical matter, meeting the [written description] requirement of § 112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed therein....” Racing Strollers, 878 F.2d at 1420. Subsequent cases explain that the written description analysis must be conducted from the perspective of an ordinary designer. For example, in finding that the inventor in Daniels had possession of a later-claimed design to a leecher without leaf ornamentation where an earlier design application depicted the leecher with leaf ornamentation, the Federal Circuit stated, “The leecher as an article of manufacture is clearly visible in the earlier design application, demonstrating to the artisan viewing that application that [the inventor] had possession at that time of the later claimed design of that article....” Daniels, 144 F.3d at 1456-57 (citations omitted) (emphasis added).

This principle is articulated again in Owens, where the Federal Circuit found that a parent application disclosing a design for a bottle with an undivided pentagonal center-front panel did not provide written description support for a continuation claiming only the trapezoidal top portion of the center-front panel. Owens, 710 F.3d at 1368. Specifically, the Federal Circuit stated that “the question for written description purposes is whether a skilled artisan would recognize upon reading the parent’s disclosure that the trapezoidal top portion of the front panel might be claimed separately from the remainder of that area.” Owens, 710 F.3d at 1368 (citing Ariad, 598 F.3d at 1351) (emphasis added). These design cases are consistent with the written description case law requiring that the application relied upon must reasonably convey to a person of skill in the art that the inventor had possession of the claimed subject matter. See Ariad, 598 F.3d at 1351 (stating, “the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art” and “[b]ased on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.”).

III. Applying the General Principles to Specific Situations in Design Applications where Issues of Compliance with the Written Description Requirement May Arise

A question as to whether the original or earlier disclosure of a design provides an adequate written description may arise when an amended claim is presented, or where a

claim to entitlement of an earlier priority date or effective filing date (e.g., under 35 U.S.C. § 120) has been made. A continuation application must comply with the written description requirement to be entitled to a parent application's effective filing date. See Owens, 710 F.3d at 1366 (citing Daniels, 144 F.3d at 1456). Similarly, an amended claim must find written description support in the original disclosure. In determining whether a claim complies with the written description requirement, an examiner would bear in mind that “the written description question does not turn upon what has been disclaimed, but instead upon whether the original disclosure ‘clearly allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’” Owens, 710 F.3d at 1368 (quoting Ariad, 598 F.3d at 1351) (alternations in original) (emphasis added).

Issues of compliance with the written description requirement may arise where a later-claimed design is composed of only a subset of originally disclosed elements (the later-claimed design does not introduce any new elements that were not originally disclosed). In the vast majority of such situations, the fact that the subset of originally disclosed elements composing the later-claimed design is visible (claimed or unclaimed) in the original/earlier application is sufficient to demonstrate to the ordinary designer viewing the original/earlier application that the inventor had possession of the later-claimed design at the time of filing the original/earlier application. See Racing Strollers, 878 F.2d at 1420 (stating “[a]s a practical matter, meeting the [written description] requirement of § 112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental

design illustrated in the later application and claimed therein....”); see also Daniels, 144 F.3d at 1456 (stating “when an issue of priority arises under § 120 in the context of design patent prosecution, one looks to the drawings of the earlier application for disclosure of the subject matter claimed in the later application” and finding that “[t]he leecher as an article of manufacture is clearly visible in the earlier design application, demonstrating to the artisan viewing that application that [the inventor] had possession at that time of the later claimed design of that article [alone without the leaf ornamentation claimed in the earlier design application]”). In these situations, no further analysis by the examiner would be necessary with respect to the written description requirement.

However, as mentioned earlier, limited situations may exist where a later-claimed design, composed of only a subset of originally disclosed elements (claimed or unclaimed), raises a question as to whether the later-claimed design is supported by the original/earlier disclosure, even though the elements composing the later-claimed design are visible in the original/earlier disclosure. An example of such limited situations is the situation in which there is an original disclosure composed of a grid of one hundred blocks (or a grid of several million pixels) and a later-claimed design composed of only a subset of interior blocks (or pixels) that form patterns (e.g., a smiling face or a frowning face). In this situation, there is a question as to whether the later-claimed design is supported by the original disclosure, even though the interior blocks (or pixels) composing the patterns are visible in the original disclosure. See also, “AIPLA Comments to USPTO on Written Description,” March 14, 2014, at page 3, available at http://www.uspto.gov/patents/law/comments/dr_a-aipla_20140314.pdf, for a similar

concept. In such limited situations, the examiner would determine whether an ordinary designer would recognize upon reviewing the complete original/earlier application that the inventor had possession of the later-claimed design in the original/earlier disclosure. See Daniels, 144 F.3d at 1456 (stating, “In general, precedent establishes that although the applicant ‘does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [the applicant] invented what is claimed.’”) (citations omitted). See also Owens, 710 F.3d at 1368 (quoting Ariad, 598 F.3d at 1351).

When making this determination, the examiner would consider what the original/earlier application, in its totality (e.g., including the title, any descriptive statements, and the drawings), would have reasonably conveyed to an ordinary designer at the time of the invention, and how an ordinary designer in the art would have designed the article that is the subject of the design claim. Such considerations can include the nature and intended use of the article embodying the claimed design as identified by the title or description (see, e.g., MPEP § 1503.01 I (9th ed. 2015)). If, based on these considerations, the examiner determines that an ordinary designer would not recognize upon reviewing the complete original/earlier application the later-claimed design in the original/earlier disclosure, the examiner would reject the claim for lack of written description (or in the case of a priority or benefit claim, the application would not be entitled to the earlier date).

Since the Office has the initial burden of establishing a prima facie case of lack of written description, should an examiner determine that a rejection is appropriate, the examiner must set forth express findings of fact which support the lack of written description determination (see MPEP § 2163 for examination guidelines pertaining to the written description requirement). Upon reply by applicant, before rejecting the claim again under 35 U.S.C. § 112(a) for lack of written description, the examiner would need to review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant, such as affidavits or declarations.

If the record as a whole demonstrates that the written description requirement is satisfied, the rejection would not be repeated in the next Office action. If, on the other hand, the record does not demonstrate that the written description is adequate to support the claim, the examiner again would reject the claim under 35 U.S.C. § 112(a), fully respond to applicant's rebuttal arguments, and properly treat any further showings submitted by applicant in the reply. When rejecting the claim again for lack of written description, the examiner would need to thoroughly analyze and discuss any affidavits or declarations filed by applicant that are relevant to the 35 U.S.C. § 112(a) written description requirement. See In re Alton, 76 F.3d 1168, 1176 (Fed. Cir. 1996).

IV. Request for Public Comments

The USPTO is requesting written public comments on the USPTO's proposed approach for applying the written description requirement in design applications as discussed in this notice. Because the USPTO is considering providing examples after reviewing public comments on the proposed approach, the USPTO also is requesting specific examples that the public believes would be helpful to illustrate the proposed approach or any suggested approach for applying the written description requirement in design applications. In particular, the USPTO is seeking examples from the public that demonstrate adequate written description as well as examples that demonstrate a lack of written description. Additionally, examples of situations in which the presence or lack of written description is not readily apparent, i.e., examples that are close to the line between adequate written description and insufficient written description, would be most helpful. Once the USPTO has considered the comments and examples received, the USPTO will determine how best to proceed in view of the public feedback on the proposed approach for applying the written description requirement in design applications.

Dated: April 8, 2016.

Michelle K. Lee

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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